



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,841	10/23/2003	Mohammed Samji	MSFT121753	6685
26389	7590	04/05/2005	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC			LY, ANH	
1420 FIFTH AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
SEATTLE, WA 98101-2347			2162	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,841

Applicant(s)

SAMJI ET AL.

Examiner

Anh Ly

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-55 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/18/05 & 2/27/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to Applicants' Preliminary Amendment filed on 03/10/2005.
2. Claims 1-55 are pending in this application.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 10, 17, 24 and 31 of the instant application is anticipated by the application of 10/729,841 claims 12, 19, 24 and 33, in that claims 12, 19, 24 and 33 of the application 10/729,841 contains all limitations of claims, 10, 17, 24 and 31 of the instant application. Claims 10, 17, 24, and 31 of the instant application therefore are not patently distinct from the application 10/729,841 limitations claims as such are unpatentable for obvious-type double patenting.

"Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claims in the earlier patent and the claims in the later patent and determines the differences. *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. *Id.* At 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claims in a commonly owned patent is invalid for obvious-type double patenting. In *Re Berg*, 140 F. 3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In *re Longi*, 759 F. 2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In *re Berg*, 140 F. 3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming

Art Unit: 2162

a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within the genus)." "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001)..

"The only other difference between claim 1 of the '213 patent and claim 7 of the '549 patent is that the former is directed to humans while the latter is directed to animals. Humans are a species of animal genus. Our case law firmly establishes that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim. In re Berg, 140 F. 3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998); In re Goodman, 11 F. 3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir 1993); In re Gosteli, 872 F. 2d 1008, 1010, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989); Titanium Metals Corp. v Banner, 778 F. 2d 775, 782, 227 USPQ 773, 779 (Fed. Cir. 1985); In re Van Ornum, 686 F. 2d at 944, 214 USPQ at 767 (C.C.P.A. 1982). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court Appeals for the Federal Circuit, ON PETITION FOR HEARING EN BANC (DECIDED: May 30, 2001)."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Pub.

No.: US 2003/0225796 A1 of Matsubara.

With respect to claim 1, Matsubara teaches creating on the sharer's computer a list with a plurality of referenced items (access control list containing an ordered list of rules and providing to limit access to a file and access control such as read, write, modify delete... can be based on the individuals or groups: see figs. 3 & 4, and sections 0043-0049); and

sharing the list with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer (access control defining the individuals or groups of individual being had access capability to access the file, sharing the file over the Internet network for peer-to-peer file sharing based on the ACL and access rights to the shared files: see fig. 2, system 100, sections 0043, 0062 and 0004-0011 and 0027).

With respect to claim 2, Matsubara teaches wherein the list is a static list (virtual directory in the server for facilitating file management by users in the client systems: section 0011).

With respect to claim 3, Matsubara teaches wherein when the sharer removes

Art Unit: 2162

items from the list, the sharee is no longer provided with access to the items (removing the user ID of the originating user of the file from the list: section 0080).

With respect to claim 4, Matsubara teaches wherein when items are added to the list, the sharee is provided with access to the added items (adding the user or file links to the file to be shared in the list: sections 0066 and 0070 and see fig. 9).

With respect to claim 5, Matsubara teaches wherein the list is a dynamic list with a scope and set of criteria for the referenced items (searching the file properties and selecting the suitable criteria to the directory structure: sections 0007 and 0062-0067).

With respect to claim 6, Matsubara teaches wherein when an item that is on the Dynamic list has a property change such that it no longer meets the criteria of the dynamic list, the sharee is no longer provided with access to the item (sections 0062-0067).

With respect to claim 7, Matsubara teaches wherein when an item that was not previously on the dynamic list has a property change such that it meets the criteria of the dynamic list, the sharee is provided with access to the item (sections 0062-0067 and 0070).

With respect to claim 8, Matsubara teaches wherein when the sharer is unable to grant access to the sharee for an item, a notification is provided to the sharer (see fig. 9 and section 0070).

With respect to claim 9, Matsubara teaches wherein the sharer is able to limit the type of access that the sharee has to the items (access control list and access rights: section 0043).

With respect to claim 10, Matsubara teaches receiving permission to access a list with referenced items (access control list giving the permission to access to the file: see fig. 11, item 1110 and section 0073); and

in response to receiving the permission to access the list, accessing the list and the referenced items (receiving the permission to access the file: see figs. 11 & 13, and sections 0073, 0079 and 0043).

With respect to claim 11, Matsubara teaches wherein the list is a static list that is formed as a virtual folder (virtual directory: sections 0011 and 0048).

With respect to claim 12, Matsubara teaches wherein when an item is added or removed from the list, the permission to access the item is correspondingly added or removed (removing the user ID of the originating user of the file from the list: section 0080; and adding the user or file links to the file to be shared in the list: sections 0066 and 0070 and see fig. 9).

With respect to claim 13, Matsubara teaches wherein the list is a dynamic list that is formed as a virtual folder with a set of criteria for the referenced items (searching the file properties and selecting the suitable criteria to the directory structure: sections 0007 and 0062-0067).

With respect to claim 14, Matsubara teaches wherein when items have changes to their properties such that they meet or no longer meet the criteria of the dynamic list, the permission to access the item is correspondingly added or removed (sections 0062-0067 and 0070).

With respect to claim 15, Matsubara teaches wherein when access to an item is

unavailable, a notification is provided (see fig. 9 and section 0070).

With respect to claim 16, Matsubara teaches wherein the permission to access the list specifies the type of access that is available for the items (access control list and access rights: section 0043).

With respect to claim 17, Matsubara teaches a set of computer-usable instructions that cause a request to provide access to a set of items that are referenced in a virtual folder to be communicated to one or more other computer-program segments capable of executing said request (P2P file sharing system, a software or browser is installed for performing searches of the file properties, such as file name, file type, file size and files can be downloaded directory from one computer to another computer , for selecting files: see fig. 1 and sections 0004-0012 and 0027; also see fig. 14, and section 0082; with access control list and access control to the file: section 0043 and virtual directory for file management by users: section 0011).

With respect to claim 18, Matsubara teaches wherein the virtual folder comprises a static list (virtual directory or virtual folder: sections 0011 and 0048).

With respect to claim 19, Matsubara teaches wherein when items are added or removed from the list, permission for the access of the items is correspondingly added or removed (removing the user ID of the originating user of the file from the list: section 0080; and adding the user or file links to the file to be shared in the list: sections 0066 and 0070 and see fig. 9).

With respect to claim 20, Matsubara teaches wherein the virtual folder comprises a dynamic list with a set of criteria for the referenced items (searching the file properties

Art Unit: 2162

and selecting the suitable criteria to the directory structure: sections 0007 and 0062-0067).

With respect to claim 21, Matsubara teaches wherein when an item has a property change such that it meets or no longer meets the criteria of the list, the permission to access the item is correspondingly added or removed (sections 0062-0067 and 0070).

With respect to claim 22, Matsubara teaches wherein when access to an item is unavailable, a notification is provided (see fig. 9 and section 0070).

With respect to claim 23, Matsubara teaches wherein the access to the items may be limited to be one of read/write or read only (access control list and access rights: section 0043).

With respect to claim 24, Matsubara teaches receiving from the sharee issues-a call for accessing on a computer of the sharer items that are referenced on the list, and responsive to authorization received from the sharer providing the sharee access to the items (P2P file sharing system, a software or browser is installed for performing searches of the file properties, such as file name, file type, file size and files can be downloaded directory from one computer to another computer , for selecting files: see fig. 1 and sections 0004-0012 and 0027; also see fig. 14, and section 0082; with access control list and access control to the file: section 0043 and virtual directory for file management by users: section 0011).

With respect to claim 25, Matsubara teaches wherein the list is a static list (virtual directory or virtual folder: sections 0011 and 0048).

With respect to claim 26, Matsubara teaches wherein as items are added or removed from the list, the access to the items is correspondingly allowed or denied (removing the user ID of the originating user of the file from the list: section 0080; and adding the user or file links to the file to be shared in the list: sections 0066 and 0070 and see fig. 9).

With respect to claim 27, Matsubara teaches wherein the list is a dynamic list with a set of criteria for the items (searching the file properties and selecting the suitable criteria to the directory structure: sections 0007 and 0062-0067).

With respect to claim 28, Matsubara teaches wherein as the properties of items change such that the items meet or no longer meet the criteria for the list, the items are correspondingly added or removed from the list (sections 0062-0067 and 0070).

With respect to claim 29, Matsubara teaches wherein when access may be unavailable to an item that is on the list when the list is shared, a notification is provided to the sharer (see fig. 9 and section 0070).

With respect to claim 30, Matsubara teaches wherein the sharer is able to limit the type of access to the items (access control list and access rights: section 0043).

With respect to claim 31, Matsubara teaches a set of computer-usable instructions that allow the sharee to access the items through the sharer's computer, wherein the list comprises an order of the items referenced on the list (P2P file sharing system, a software or browser is installed for performing searches of the file properties, such as file name, file type, file size and files can be downloaded directory from one computer to another computer, for selecting files: see fig. 1 and sections 0004-0012 and

0027; also see fig. 14, and section 0082; with access control list and access control to the file: section 0043 and virtual directory for file management by users: section 0011).

With respect to claim 32, Matsubara teaches wherein the list is one of a static list and a dynamic list (virtual directory: sections 0011 and 0048; also see abstract).

With respect to claim 33, Matsubara teaches wherein as items are added or removed from the list, the sharee's permission to access the items is correspondingly added or removed (section 0073 and see figs. 7 and 11).

With respect to claim 34, Matsubara teaches wherein when the sharer attempts to provide access to an item for which access may not be available, a notification is provided to the sharer that the sharee may not be able to access the item (see fig. 9 and section 0070).

With respect to claim 35, Matsubara teaches wherein the type of access that is provided to the items may be one of read or read-write (access control list, access control and access right: section 0043).

With respect to claim 36, Matsubara teaches creating on the sharer's computer a virtual folder with a plurality of referenced items, and sharing the virtual folder with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer (in P2P file sharing system having a software component to create and maintain the virtual directory or virtual folder in the file management by users system: sections 0011 and 0048; P2P file sharing system, a software or browser is installed for performing searches of the file properties, such as file name, file type, file size and files can be downloaded directory from one computer to another computer, for

Art Unit: 2162

selecting files: see fig. 1 and sections 0004-0012 and 0027; also see fig. 14, and section 0082; with access control list and access control to the file: section 0043).

With respect to claim 37, Matsubara teaches wherein the virtual folder is a static virtual folder (virtual directory; section 0011).

With respect to claim 38, Matsubara teaches wherein when the sharer removes items from the virtual folder, the sharee is no longer provided with access to the items (section 0073 and see figs. 7 and 11).

With respect to claim 39, Matsubara teaches wherein when items are added to the virtual folder, the sharee is provided with access to the added items (section 0073 and see figs. 7 and 11).

With respect to claim 40, Matsubara teaches wherein the virtual folder is a dynamic virtual folder with a scope and set of criteria for the referenced items (searching the file properties and selecting the suitable criteria to the directory structure: sections 0007 and 0062-0067).

With respect to claim 41, Matsubara teaches wherein when an item that is in the dynamic virtual folder has a property change such that it no longer meets the criteria of the dynamic virtual folder, the sharee is no longer provided with access to the item (file properties: section 0005-0007, and 0062, virtual directory: section 0011).

With respect to claim 42, Matsubara teaches wherein when an item that was not previously on the dynamic virtual folder has a property change such that it meets the criteria of the dynamic virtual folder, the sharee is provided with access to the item (sections 0011 and 0048).

With respect to claims 43-44, Matsubara teaches wherein the creating step comprises defining within the list an order of the plurality of referenced items, wherein the creating step comprises defining within the list an annotation corresponding to at least one of the plurality of referenced items (access control list: sections 0043 and 0073, see fig. 11).

With respect to claims 45-46, Matsubara teaches wherein the list comprises a predefined order of the referenced items, wherein the list comprises an annotation corresponding to at least one of the referenced items (access control list: sections 0043 and 0073, see fig. 11).

With respect to claims 47-48, Matsubara teaches wherein the list comprises a predefined order of the referenced items, wherein the list comprises an annotation corresponding to at least one of the referenced items (access control list: sections 0043 and 0073, see fig. 11).

With respect to claim 49, Matsubara teaches wherein the sharee is provided with remote access to the referenced items from another computer (see fig. 1).

With respect to claim 50, Matsubara teaches wherein accessing the list and the referenced items is performed remotely from another computer (see fig. 1).

With respect to claim 51, Matsubara teaches wherein the request to provide access comprises a request to provide remote access from another computer (see fig. 1).

With respect to claim 52, Matsubara teaches wherein providing the sharee access to the items comprises providing the sharee remote access to the items (see fig. 1).

With respect to claim 53, Matsubara teaches wherein the receiving step comprises receiving the call via an API (browser in windows-based interfaces; section 0033-0034).

With respect to claim 54, Matsubara teaches wherein the set of computer-usable instructions allow the sharee to remotely access the items (P2P file sharing Internet network environment: section 0004-0012 and abstract, see fig. 1).

With respect to claim 55, Matsubara teaches wherein in the sharing step the sharee is provided with remote access to the referenced items (P2P file sharing Internet network environment: section 0004-0012 and abstract, see fig. 1).


Contact Information


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV or fax to (571) 273-4039. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or Primary Examiner Jean Corrielus (571) 272-4032.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: Central Fax Center (703) 872-9306

ANH LY 
MAR. 29th, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER